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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,722	05/23/2001	John R. Martin	10527US16	2165
7590	09/21/2007		EXAMINER	
John J. Held, Esq. McAndrews, Held & Malloy, Ltd. 34th Floor 500 West Madison Street Chicago, IL 60661			JABR, FADEY S	
			ART UNIT	PAPER NUMBER
			3628	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	09/863,722	MARTIN ET AL.
	Examiner	Art Unit
	Fadey S. Jabr	3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 July 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 16,17 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 16,17 and 20-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/2/07, 8/13/07</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 16-17 and 20-31 remain pending and are again presented for examination.

Response to Arguments

1. Applicant's arguments filed 2 July 2007 have been fully considered but they are not persuasive.
2. Examiner notes the typo (March 6, 1992 and not March, 6, 1998) in the reference to the applicant's priority claim.
3. Applicant argues that the current application and the '302 patent provide support for, and enable, the claims. Examiner agrees that the paragraph, specifically referring to Fig. 5, that the applicant refers to in the arguments provides support for the claim "user attract mode". Thus, the Examiner agrees that priority to a date of March 6, 1992 shall be given to the current application. The applicant's arguments however only provide evidence to the fact that the current application that claims priority to the '302 and has a date of March 6, 1992 should receive a priority date of March 6, 1992 and **not** June 15, 1990. The above cited paragraph referring to Fig. 5 was not found within the original 07/538,981 application. The Examiner has also reviewed the original 07/538,981 has not found support for the above user attract mode feature. Thus, the current application shall only be provided a priority date back to the '302 patent, which has a priority date of March 6, 1992.
4. Applicant argues that the Office has not shown that the Smith patent qualifies as prior art with respect to the compression/decompression and user attract limitations recited in the claims.

However, Examiner has read the disclosure of the Smith 07/815,217 patent application (filing date 13 December 1991, which antedates the applicant's present claim for priority) and has asserts that support has been found for the relied upon disclosure. For instance, Smith teaches storing compressed and uncompressed video frame, audio, and text data in the '217 application (Page 5, lines 11-14). Furthermore, Smith teaches many of the standard features performed by known user interfaces are included in the integrated information support system of the present invention. Special frames are provided, such as idle time or warmup display (Page 9, lines 20-27). Therefore, the Office has shown that the Smith reference qualifies as prior art with respect to the claim limitations. Further, the Office has proven that the Smith '217 application antedates the '302 patent of the applicant.

Priority

5. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

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The disclosure of the prior-filed application, Application No. 07/538,981, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Support for the attract mode feature of the current application was not found in the 07/538,981 application.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16-17, 20, 22-23 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castille, U.S. Patent No. 5,497,502 in view of Cohen, U.S. Patent No. 4,949,187 and Smith et al., U.S. Patent No. 6,601,150, hereinafter referred to as Castille, Cohen and Smith respectively.

As per Claim 16, Castille discloses:

a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;

a data storage unit for storing, see column 5, lines 28-29, images and associated digital song data, see column 1, lines 17-29,

a display for showing, to a prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song

identity data, see column 5, lines 1-25, and figure 1 (15);
selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys, see column 5, lines 1-25 and figure 1 (15);
at least one audio speaker, see figure 1 (17);
a processor connected to a memory, the memory including a decompression algorithm for decompressing compressed digital song data, see column 5, lines 6-10;
causing the processor, in response to the signal output, to access and process digital song data received from the data storage unit so that the accessed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;
causing the processor to decompress the accessed digital song data and send the digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored song digital data being and converted by the processor and the digital to analog converter, see column 5, lines 6-10; and
Castille discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit.

Cohen teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1-6. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox, to control the storage of the received

compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen to create an updated library of songs stored in the computer jukebox.

Castille does not disclose a compressing and decompressing song data or a user attract mode wherein song associated images are shown.

Smith teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

As per Claim 17, Castille does not specifically disclose: instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting song usage data under the control of the processor. Cohen teaches instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, see column 5, lines 2-7, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting song usage data under the control of the processor, see column 4, lines 26-29 for the benefit of providing users with convenient access to videos and ensure proper royalty payments. Therefore, it would have been obvious to One of ordinary skill in the art, at the time the invention was made to display the updated list of songs and store song.

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usage data as taught by Cohen for the benefit of providing users with convenient access to videos and ensure proper royalty payments.

As per Claim 20, Castille further discloses communication interface is telecommunication and further the storage of file identity data, see column 4, line 62 - column 5, line 29.

As per Claim 22, Castille discloses: a plurality of computer jukeboxes, capable of playing songs selected by users of the jukebox from a library of songs that have been digitally compressed and stored in the computer jukebox, see figure 1 (15) and column 4, lines 1-11 ; a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5; a data storage unit for storing, see column 5, lines 28-29; a display for showing, to a prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15); selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys, see column 5, lines 1-25 and figure 1 (15); at least one audio speaker, see figure 1 (17);

a processor connected to a memory, the memory including digital song data, see column 5, lines 6-10;

a digital to analog converter coupled between the processor and the audio speaker to convert digital song data to an analog signal coupled to the speaker, see figure 1 (47);

causing the processor, in response to the signal output, to access and process digital song data received from the data storage unit so that the accessed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;

causing the processor to send the digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored song digital data being and converted by the processor and the digital to analog converter, see column 5, lines 6-10; and

Castille discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit and a management station for updating the library of songs in each of the plurality of jukeboxes.

Cohen teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1-6, from a management station, see figure 4 (36) with communication interface (58), processor (36), storing digital song data (12, 14, 16, 18, 20, 22, 24, 26), data compressor (58) and transmitter (58) and column 1, lines 46-61.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox from a

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management station, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen to create an updated library of songs stored in the computer jukebox.

Castille does not disclose a compressing and decompressing song data or a user attract mode wherein song associated images are shown.

Smith teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and. an attract mode, see column 7, lines 63-66 to increase machine usage. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

As per Claims 23, Castille further discloses bi-directional communications, see figure 1 (2).

As per Claims 25, Castille does not specifically disclose the display of the updated list. Cohen teaches instructions causing the processor to display the updated library of songs, see column 5, lines 2-7 for the benefit of providing users with convenient access to videos. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the updated list of songs as taught by Cohen for the benefit of providing users with convenient access to videos.

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As per **Claims 26**, Castille does not specifically disclose the storage of usage data.

Cohen teaches instructions causing the processor to store usage data, see column 4, lines 26-29 for the benefit of ensuring proper royalty payments. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to store usage data as taught by Cohen for the benefit of ensuring proper royalty payments.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castille in view of Cohen in view of Smith further in view of Verduin et al., U.S. Patent No. 4,667,802, hereinafter referred to as Verduin.

As per Claim 27. Castille discloses:

a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;

a data storage unit for storing, see column 5, lines 28-29;

a display for showing, to a prospective user, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);

a processor and a memory, the memory, see column 5, lines 6-10;

and instructions:

causing the processor, in response to the signal output, to access and process song data received from the data storage unit so that the accessed song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;

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causing the processor send the digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored song digital data being and converted by the processor, see column 5, lines 6-10; and Castille discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit and a management station for updating the library of songs in each of the plurality of jukeboxes.

Cohen teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1-6, from a management station, see figure 4 (36) with communication interface (58), processor (36), storing digital song data (12, 14; 16, 18, 20, 22, 24, 26), data compressor (58) and transmitter (58) and column 1, lines 46-61. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox from a management station, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen to create an updated library of songs stored in the computer jukebox. Castille does not disclose a compressing and decompressing song data or a user attract mode wherein song associated images, are shown.

Smith teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently

using available storage capacity and have an attract mode to increase machine usage.

Castille does not disclose a money intake device or a user attract mode wherein song associated images are shown.

Verduin teaches a money intake device, see figure 1 (32), an attract mode displaying selected graphics when no selection is playing, column 1, lines 47-49, for the benefit of attracting customers and taking their money. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display song associated images and have a money intake device as taught by Verduin to attract users to the device and taking their money.

9. Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castille in view of Smith et al.

As per Claim 28, Castille discloses:

a communication interface for receiving the compressed digital song data and the song identity data, see column 3, lines 13-18 and column 4, lines 1-24;
a processor having a memory connected thereto, the memory including digital song data, see column 3, lines 19-24. Castille does not disclose compressing and decompressing song or graphics data or an attract mode. Smith teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompressing associated graphics for the

benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

As per Claim 29, Castille discloses: a processor and a memory, see column 3, lines 13-24 and column 4, lines and Castille et al does not disclose decompressing song or graphics data or an attract mode. Smith teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

As per Claim 30, Castille does not disclose a user attract mode wherein song associated images are shown when no song is playing. Smith teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

As per Claim 31, Castille does not disclose a user attract mode wherein song associated images are shown when no song is playing. Smith teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-1516 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

John Hayes
JOHN W. HAYES
SUPERVISORY PATENT EXAMINER